

E1  
Concl

(d) gripping the unbound partial bundles using at least one gripping element;  
(e) releasing the unbound partial bundles from the at least one gripping element; and  
(f) placing the unbound partial bundles in a first collection trough of a collection device; and  
(g) repeating steps (a) to (f) sequentially for the required number of unbound partial bundles until a required thickness of the fiber bundle is obtained.

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E2

5. (Three Times Amended) A method for manufacturing fiber bundles comprising the steps, performed sequentially, of:  
transporting a fiber bundle using at least one feed element;  
cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length;  
releasing the unbound partial bundles from the at least one feed element;  
gripping the unbound partial bundles using at least one gripping element;  
releasing the unbound partial bundles from the at least one gripping element;  
placing the unbound partial bundles having the same lengths in a first collection trough of a collection device; and  
rotating the collection device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough.

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## REMARKS

### I. Introduction

Claims 1 and 5 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants note with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

### II. Rejection of Claims 1 and 5 Under 35 U.S.C. § 102(b)

Claims 1 and 5 were rejected under 35 U.S.C. 102(b) as anticipated by U.S. Patent No. 1,965,464 ("Koehler"). Applicants respectfully submit that Koehler

does not anticipate claims 1 and 5 as amended for the following reasons.

Claim 1 relates to a method for manufacturing a fiber bundle having a length from a required number of unbound partial bundles having the same lengths. Claim 1 recites that the method comprises the steps of transporting a fiber bundle strand using at least one feed element and cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having said length. Claim 1 also recites that the method includes the steps of releasing the unbound partial bundles from the at least one feed element and gripping the unbound partial bundles using at least one gripping element. In addition, claim 1 recites that the method includes the steps of releasing the unbound partial bundles from the at least one gripping element and placing the unbound partial bundles in a first collection trough of a collection device. Claim 1 has been amended herein to recite that these steps are repeated sequentially for the required number of unbound partial bundles until a required thickness of the fiber bundle is obtained.

Claim 5 relates to a method for manufacturing fiber bundles. Claim 5 has been amended to recite that the method includes the steps, performed sequentially, of transporting a fiber bundle using at least one feed element and cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length. Claim 5 recites that the method includes the step of releasing the unbound partial bundles from the at least one feed element. Claim 5 also recites that the method includes the step of gripping the unbound partial bundles using at least one gripping element. Claim 5 further recites that the method includes the step of releasing the unbound partial bundles from the at least one gripping element. In addition, claim 5 has been amended herein to recite that the method includes the step of placing the unbound partial bundles having the same lengths in a first collection trough of a collection. Claim 5 also recites that the method includes the step of rotating the collection device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough.

Koehler purports to describe a machine for making tassels. Col. 1, lines 1-2. More specifically, Koehler states that "the machine makes tassels of the type in which short sections of threads or cords ... are folded to form an eye and bound together adjacent to the eye by means of a wire ring or staple." Col. 1, lines 2-6.

The Office Action states that "Koehler discloses all the recited steps of

the invention including: a) transporting a fiber bundle strand using at least one feed element (52, 53); b) cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length (74, 75); c) releasing the unbound partial bundles from the at least one feed element (page 2 lines 72-81); d) gripping the unbound partial bundles using at least one gripping element (65, 66); e) releasing the unbound partial bundles from the at least one gripping element (page 2, lines 82-92); f) placing the unbound partial bundles in first collection trough (26) of a collection device (25); g) repeating steps a) to f) for the required number of unbound partial bundles (page 2, lines 36-39).” Office Action at pages 2 to 3. The Office Action also states that “[i]t is noted that claim 1 does not preclude a step of bounding partial bundles [and that it] merely requires steps a) to f) being repeated to place the required number of unbound partial bundles in the first collection trough.” Office Action at page 3. The Office Action also states that “[e]ach element 26 is construed as being ‘a first collection trough’ of the collection device (25).” Office Action at page 3. The Office Action also states that “[w]ith respect to claim 5, see page 2, lines 36-39 for a step of ‘rotating the collection trough device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough.’” Office Action at page 3. The Office Action also states that “[e]lement 26 adjacent to the first collection trough (26) is construed as being ‘a further collection trough’ ... [and] claim 5 does not preclude a step of bounding partial bundles ... [nor does claim 5] call for a step of rotating the collection device while the unbound partial bundles in the first collection trough remains unbound.” Office Action at page 3. The Office Action further states that “the claims do not require the recited steps to be performed sequentially or in a particular order such that it does not preclude some steps being performed simultaneously [and that the] alphabetical numbering in claim 1 does not indicate these steps are being performed in a particular order.” Office Action at page 3.

It is respectfully submitted that Koehler fails to disclose, or even suggest, manufacturing a fiber bundle having a length by placing a number of unbound partial bundles having the same lengths in a collection trough until a required thickness of the fiber bundle is obtained, as recited in amended claim 1. Furthermore, it is respectfully submitted that Koehler fails to disclose, or even suggest, manufacturing a fiber bundle by cutting a fiber bundle strand into unbound partial bundles and then placing the unbound partial bundles having the same

lengths in a collection trough, as recited in amended claim 5. In contrast, Koehler describes a process whereby threads or cords are folded to form an eye and are bound together adjacent to the eye by means of a wire ring. More specifically, in Koehler, threads 51 and 54 are fed through tubes 52 and 55, respectively, where they are clamped, folded, etc. Page 2, lines 42-51. After the threads or cords have been bound together to form the tassel, the ends of the threads or cords are cut by knives 74 and 75. Page 2, lines 93-96. Thus, at most Koehler describes that a predetermined number of threads or cords are simultaneously fed through tubes and then are folded and cut. This is in direct contravention with claim 1, which recite the manufacturing of a fiber bundle strand having a length by placing a number of unbound partial bundles having the same lengths in a collection trough until a required thickness of the fiber bundle is obtained. This is in direct contravention with claim 5, which recite manufacturing a fiber bundle by cutting a fiber bundle strand into unbound partial bundles and then placing the unbound partial bundles having the same lengths in a collection trough until a required thickness of the fiber bundle is obtained.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that Koehler does not disclose, or even suggest, manufacturing a fiber bundle having a length by placing a number of unbound partial bundles having the same lengths in a collection trough until a required thickness of the fiber bundle strand is obtained, as recited in amended claim 1, nor does Koehler disclose, or even suggest, manufacturing a fiber bundle by cutting a fiber bundle strand into unbound partial bundles and then placing the unbound partial bundles having the same lengths in a collection trough, as recited in amended claim 5.

Additionally, to reject a claim under 35 U.S.C. § 102, the Examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See, Scripps Clinic & Research Foundation v. Genentech, Inc., 18

U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). Still further, not only must each of the claim limitations be identically disclosed, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. See, Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). In particular, it is respectfully submitted that, at least for the reasons discussed above, the reference relied upon would not enable a person having ordinary skill in the art to practice the inventions of the rejected claims, as discussed above. Also, to the extent that the Examiner is relying on the doctrine of inherency, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." See M.P.E.P. § 2112; emphasis in original; and see, Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, the anticipation rejection as to the rejected claims must necessarily fail for the foregoing reasons.

In summary, it is respectfully submitted that Koehler does not anticipate claims 1 and 5.

### **III. Conclusion**

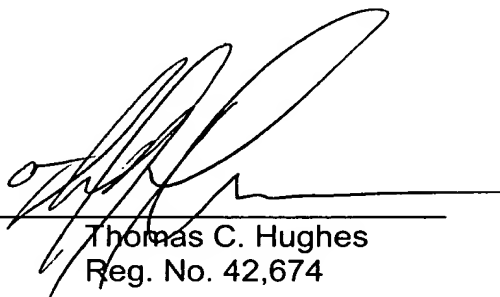
Attached hereto is a marked-up version of the changes made to the claims by the current Amendment. The attached page is captioned "**Version with Markings to Show Changes Made.**"

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,  
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**Version with Markings to Show Changes Made**

**IN THE CLAIMS:**

Claims 1 and 5 have been amended without prejudice as follows:

1. (Four Times Amended) A method for manufacturing a fiber bundle having a length from a required number of unbound partial bundles having the same lengths, the method comprising:

- (a) transporting a fiber bundle strand using at least one feed element;
- (b) cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having said length;
- (c) releasing the unbound partial bundles from the at least one feed element;
- (d) gripping the unbound partial bundles using at least one gripping element;
- (e) releasing the unbound partial bundles from the at least one gripping element; and
- (f) placing the unbound partial bundles in a first collection trough of a collection device; and
- (g) repeating steps (a) to (f) sequentially for the required number of unbound partial bundles until a required thickness of the fiber bundle is obtained.

5. (Three Times Amended) A method for manufacturing fiber bundles comprising the steps, performed sequentially, of:

- transporting a fiber bundle using at least one feed element;
- cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length;
- releasing the unbound partial bundles from the at least one feed element;
- gripping the unbound partial bundles using at least one gripping element;
- releasing the unbound partial bundles from the at least one gripping element;
- placing the unbound partial bundles having the same lengths in a first collection trough of a collection device; and
- rotating the collection device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough.